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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DANG, THANH HA T

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/601,812	Applicant(s) MACMILLAN, BRUCE DANIEL	
	Examiner Thanh-Ha Dang	Art Unit 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 8-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/23/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-3 and 8-20 are rejected in this Office Action.
2. Applicant cancelled Claims 4-7.
3. This Action is made Final.

Response to Amendment

4. Receipt of Applicant's Amendment filed 05/14/08 is acknowledged.
5. Applicant's Amendment overcomes the claim objections concerning claim 17 and the claim rejections - 35 USC § 112 (2nd) concerning claims 2 and 15, therefore the objection and rejection are withdrawn.

Claim Rejections - 35 USC§ 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 8-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No. US2004/0064445 issued to Pfleging et al. ("Pfleging"), further in view of Pub. No. US2003/0130857 issued to Matsuo

("Matsuo"), further in view of US Patent No. 6,029,192 issued to Hill et al. ("Hill"), and further in view of US Patent No. 6,820,204 issued to Desai et al. ("Desai").

As to **Claims 1, 17 and 20**, *Pfleging teaches* a method for retrieving information in a private database, the method comprising:

- receiving, via an e-mail, a request from a wireless communication device to retrieve the information in the private database (*Figures 1 and 2A-B, page 2 [0014-0016]*);
- sending a query to retrieve the information (*Figures 2A-B, page 2 [0014, lines 3-5 and lines 19-23]; [0015]; and [0016]*)
- sending the information to the wireless communication device (*Figure 2B block74, page 2 [0016]*); and
- if the identified e-mail address is not on the list, then denying the request to retrieve the information in the private database (*Figure 2A block58 and 60, page 2 [0014, lines 15-18 wherein a NO determination is equivalent to denying the request to retrieve the information in the private database]*).
- *Pfleging does not explicitly teach* upon receiving the request, comparing an e-mail address identified with the wireless communication device against a list of e-mail addresses residing at the e-mail server, and if the identified e-mail address is on the list, then authorizing retrieval from the private database. However,
Matsuo teaches upon receiving the request, comparing an e-mail address identified with the wireless communication device against a list of e-mail

addresses residing at the e-mail server, and if the identified e-mail address is on the list, then authorizing retrieval from the private database (*Figure 10, page 6 [0059, wherein the authorized parties stored in the database read on the list limitation]*). Thus, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine method for utilizing an information exchange framework teaching of Matsuo with wireless access to a database by message query teaching of Pfleging to provide method and system which read on the list of e-mail addressees limitation.

- *Pfleging in combination with Matsuo does not explicitly teach* receiving a response to the query, wherein the response includes the information, wherein the information comprises a list of documents which are listed by order of relevance. However,

Hill teaches receiving a response to the query, wherein the response includes the information, wherein the information comprises a list of documents which are listed by order of relevance (*Figure 14 block1402, column 11, line 15*). Thus, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine resource evaluation derived from electronic messages teaching of Hill with method for utilizing an information exchange framework teaching of Matsuo and wireless access to a database by message query teaching of Pfleging to provide method and system which display information by order of relevance.

- *Pfleging, Matsuo in combination with Hill does not explicitly teach at an e-mail server. However, Desai teaches at an e-mail server (Figure 1, block30, column 10, lines 44-45). Thus, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine system and method for selective information exchange teaching of Desai with resource evaluation derived from electronic messages teaching of Hill, method for utilizing an information exchange framework teaching of Matsuo, and wireless access to a database by message query teaching of Pfleging to provide method and system which include an e-mail server to read on the claimed limitation.*

As to **Claim 2**, *Pfleging, Matsuo, Hill in combination with Desai teaches wherein receiving the request includes receiving the e-mail from the wireless communication device (Pfleging, page 1 [0011]).*

As to **Claim 3**, *Pfleging, Matsuo, Hill in combination with Desai teaches wherein receiving the e-mail from the wireless communication device includes receiving the e-mail from one of a wireless telephone, a wireless pager and a wireless personal digital assistant (Desai, column 3, lines 49-55).*

As to **Claim 8**, *Pfleging, Matsuo, Hill in combination with Desai teaches wherein sending the query includes identifying text in the e-mail (Hill, Figure 4, column 5, lines 40-47).*

As to **Claim 9**, *Pfleging, Matsuo, Hill in combination with Desai wherein identifying text in the e-mail includes identifying a word associated with the*

information (*Pfleging, Figure 4, page 2 [0019, wherein the request "C: Cruise" is to search for a cast member with the name "Cruise" wherein searching inherently identifying the word "Cruise"]*).

As to **Claim 10**, *Pfleging, Matsuo, Hill in combination with Desai teaches wherein identifying the word in the e-mail includes identifying an acronym associated with the information (Pfleging, page 2 [0019, lines 8-11 wherein the example shows U:026359927324 which describes U as an acronym associated with the UPC code information])*.

As to **Claim 11**, *Pfleging, Matsuo, Hill in combination with Desai teaches wherein identifying text in the e-mail includes identifying a phrase associated with the information (Pfleging, page 2 [0019, wherein the search criteria identifies a phrase associated with the information, e.g., "T: Star Wars"])*.

As to **Claims 12 and 13**, *Pfleging, Matsuo, Hill in combination with Desai teaches wherein identifying text in the e-mail includes identifying a letter and a number associated with the information (Hill, column 5, lines 48-53 wherein mailing address425/URL428 read on letter and a number associated with the information)*.

As to **Claim 14**, *Pfleging, Matsuo, Hill in combination with Desai teaches wherein receiving the response includes receiving the information (Hill, Figure 14, column 11, lines 9-13 wherein receiving the search result read on the claimed limitation)*.

As to **Claim 15**, *Pfleging, Matsuo, Hill in combination with Desai teaches* wherein sending the information to the wireless communication device includes sending an outbound e-mail to the wireless communication device (*Pfleging, Figure 2B block70-74, page 2 [0016, lines 4-9]*).

Claim 16 has similar limitations to Claim 1, and therefore is rejected under the same rationale as Claim 1.

As to **Claim 18**, *Pfleging, Matsuo, Hill in combination with Desai teaches* wherein the e-mail server comprises a portion of an Intranet (*Matsuo, page 10 [0114, line 4]*).

As to **Claim 19**, *Pfleging, Matsuo, Hill in combination with Desai teaches* wherein the e-mail server comprises a portion of an Extranet (*Matsuo, page 10 [0114, line 5]*).

Response to Applicant Arguments

7. Applicant's arguments with respect to claims 1-3 and 8-20 have been fully considered but they are not persuasive. Examiner respectfully maintains the rejection cited for the following reasons:

- Applicant argues: Applicant states in paragraphs 3-5 of page 8 that "Applicant respectfully asserts that, taking the claim and the references as a whole, there would have been no motivation for one of ordinary skill in the art to combined Desai with Pfleging, Matsuo or Hill because Desai teaches away

from the claim elements ... As such, a prima facie case of obviousness has not been established and the rejection must fail for at least these reasons.”

Examiner responds: In response to applicant's argument that a prima facie case of obviousness has not been established, Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.1992). Thus, Pfleging teaches on page 2 [0014] wherein the message carrying the SMS query is received at server18 where it is converted into SMTP e-mail and transmitted by Internet20, wherein the e-mail message containing the query is received at the host SMTP server26. Therefore, server18 and server26 read on an e-mail server since both servers support and provide e-mail application functionality. Furthermore, Pfleging also teaches other applicant's broad claims' elements as addressed in the above Rejection Section. Furthermore, Matsuo teaches in Abstract wherein the information exchange framework may be utilized as a forwarding intermediary during the exchange of e-mail communications between parties that is illustrated in Figure 11 and further detailed on page 6 [0059-0060] that read on applicant's broad claims. Hill teaches in Figure 14 column 9 lines 56-67 information sorting and ordering

that read on applicant's broad claims. Furthermore, Desai teaches e-mail system server on column 11 lines 37-39 and column 25 lines 50-65 that is further illustrated in Figures 1-4 that read on applicant's broad claims. Subsequent to an analysis of the claims it was revealed that a number of limitations recited in the claims belong in the prior art and thus encompassed and/or implicitly disclosed in the references applied and cited. It is logical for the examiner to focus on the limitations that are "crux of the invention" and not involve a lot of energy and time for the things that are not central to the invention, but peripheral. The examiner is aware of the duties to address each and every element of claims, however, it is also important that a person prosecuting a patent application before the Office or an stakeholders of patent granting process make effort to understand the level of one of ordinary skill in the (data processing) art or the level one of skilled in the (data processing) art, as encompassed by the applied and cited references. Furthermore, Pfleging, Matsuo, Hill, and Desai are in the same field of endeavor of which their teachings include information and data accessing using e-mail service and application in a network system with related software and hardware environments. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to apply the teachings of Pfleging, Matsuo, Hill, and Desai to provide method and system to access information, wherein information accessing involves locating resources on a network using resource evaluation derived from electronic messages (i.e., e-

mail), wherein wireless access to a database by a short message system query is utilized, wherein system and method for selective information exchange is implemented, wherein information exchange framework is utilized during the exchange of e-mail communications that read on applicant's claimed invention. Thus, combining the cited teachings provide an enhancement to the teachings that read on applicant's claimed invention. Hence, it is obvious to a person of ordinary skill in the art to combine the cited prior arts, and therefore Examiner has met the burden that establishes prima facie case of obviousness.

- Applicant argues: Applicant states in paragraph 2 of page 9 that "Further the combination of Pfleging, Matsuo, Hill and Desai fails to describe each and every claim element."

Examiner responds: Examiner is not persuaded. In view of the reasons stated above and the rejection addressed in this office action, Pfleging, Matsuo, Hill, in combination with Desai teaches each and every claim element.

Citation of Pertinent Prior Art

8. The prior art made of record and not relied upon in form PTO-892 if any is considered pertinent to applicant's disclosure.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THANH-HA DANG whose telephone number is (571)272-4033. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thanh-Ha Dang
Examiner, AU 2163
August 4, 2008

/don wong/
Supervisory Patent Examiner, Art Unit 2163